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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,251	05/31/2001	Holgers Eggers	MO-6276/WW-5	4221

7590 12/02/2003

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EXAMINER

KRUER, KEVIN R

ART UNIT PAPER NUMBER

1773

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/807,251

Applicant(s)

EGGERS ET AL.

Examiner

Kevin R Kruer

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 7-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. This application contains claims 7-9 drawn to an invention nonelected with traverse in Paper No. 10. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1, 3, 4, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Maxfield et al (US 5,385,776) for reasons of record.

Claim Rejections - 35 USC § 103

4. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goehring et al (US 3,791,915) in view of Maxfield et al (US 5,385,776) for reasons of record.

Response to Arguments

Applicant's arguments filed October 16, 2003 have been fully considered but they are not persuasive.

Applicant notes that the Office Action inadvertently reported the particle sizes of the particulate material in Maxfield in microns. The particle sizes should have been reported in nanometers. The examiner apologizes for this error and any inconvenience it may have caused.

Applicant argues that it is neither disclosed nor known (at the time of the invention of Maxfield) which role the particulate material plays and there would be no reason for one of ordinary skill in the art to believe that the particulate material acts as a crystal nucleus of gamma phase crystallites. However, the courts have held that the mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. In *re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979).

Applicant further argues that Maxfield does not teach teaches or suggest the size and amounts of crystallites in the gamma phase. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the size and amounts of crystallites in the gamma phase) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant further argues that Maxfield discloses a polyamide polymer matrix that comprise gamma phase material, and the addition of the particulate material only contributes to increasing the amount of gamma phase material in the matrix. However, Applicant's claim read on any "polyamide containing" layer. Thus, the claims read on polyamide polymer matrixes that comprise gamma phase material. Furthermore, Applicant's preferred polyamide, "polyamide which is formed in a proportion amounting to at least 90 percent by weight from epsilon caprolactam (claim 3)," is a gamma phase polyamide (col 1, lines 51+) as taught in Maxfield.

According to applicant, Maxfield also does not teach or suggest a special size of crystallites in the gamma phase of the polyamide that achieves the desired properties that Applicants have been able to produce. Applicant further argues that Maxfield does not teach improved optical appearance or low after-shrinkage. However, the size of the crystallites, the "desired properties," the optical appearance, and the dimensional stability have not been claimed. Furthermore, the examiner notes that Maxfield teaches the claimed matrix polymer, the claimed filler (A) with the claimed aspect ratio and orientation. The size of crystallites, optical appearance, and dimensional stability would all be considered latent properties that are present in the composition/laminate of Maxfield. The courts have held that the mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979).

With respect to Goehring in view of Maxfield, Applicant argues that Goehring teaches a zinc compound must be present. Applicant argues that said zinc compound is not necessary in the current invention. However, Applicant's claims are "open," and therefore allow the presence of said zinc compound.

Applicant further argues that the films of Goehring are laminated whereas the claimed films can be extruded. However, such a limitation is not claimed. Furthermore, the courts have held that a method of making a product does not differentiate that product from a product taught in the prior art unless it can be shown that the method of making the product inherently results in a materially different product. There is no such showing on record.

Applicant argues that the combination of Goehring in view of Maxfield would not render the claimed invention obvious, but does not provide any evidence of how such a conclusion was reached. Applicant is reminded that counsel's arguments cannot take the place of evidence.

Therefore, the rejections are maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 703-305-0025. The examiner can normally be reached on Monday-Friday from 7:00a.m. to 4:00p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone

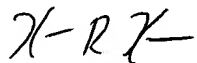
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number for the organization where this application or proceeding is assigned is 703-305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Kevin R. Kruer

Patent Examiner-Art Unit 1773


Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700